

Docket No.: 059036-0040

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sergey N. RAZUMOV

RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE

Application No.: 10/762,375

Customer No.: 20277

Filed: January 23, 2004

Confirmation No.: 4460

Group Art Unit: 3625

Examiner: A. A. Shah

Title: MULTIMEDIA TERMINAL FOR PRODUCT ORDERING

REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.116

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is submitted in response to the Office Action mailed September 6, 2006.

REQUEST FOR WITHDRAWAL OF FINALITY OF THE REJECTION

As demonstrated below, the final Office Action mailed September 6, 2006 is improper.

In the previous Office Action, the Examiner applied the patent application publication of Gosewehr (2004/0249724) in rejecting the claims 1-28 of the present application. In particular, the Examiner relied upon paragraphs [25] and/or [40] of the reference in her rejections of claims 1, 3, 4, 6-8, 10-12, 14, 16-18, 20-22, and 24-26.

In response, the Applicant submitted that the Gosewehr application was filed on April 21, 2004. Therefore, its subject matter is not available as a reference against the present application filed on January 23, 2004.

Further, the Applicant submitted that although the Gosewehr application relies upon the priority of the provisional application 60/475,738 filed on June 4, 2003, the provisional application does not contain the subject matter of paragraphs [25] and [40] relied upon by the Examiner in the rejections.

It is well settled that a reference, which claims priority to a prior US provisional application would be accorded the earlier filing data of the provisional application as its prior art date, assuming the earlier-filed application has proper support for the subject matter relied upon (MPEP 706.02(f)(1)).

As the provisional application '738 does not disclose the subject matter of paragraphs [25] and [40] of the Gosewehr publication, this publication is not accorded the filing date of the provisional application '738 for the subject matter of paragraphs [25] and [40].

It appears that the Examiner admits that the subject matter of paragraphs [25] and [40] is not available as a prior art because she raises new arguments with respect to claims 1 and 16 relying only on the subject matter of the provisional application '738.

However, in the final rejection of the claims 3, 4, 6-8, 10-12, 14, 17, 18, 20-22, and 24-26, the Examiner still relies upon the subject matter of paragraphs [25] and/or [40] of the Gosewehr publication despite the fact that this subject matter was added to the Gosewehr application after the filing date of the present patent application.

In accordance with 37 CFR 1.113(b), in making the final rejection, the Examiner shall repeat or state all grounds of rejection **then** considered applicable to the claims in the application, clearly stating the reasons in support thereof.

However, as demonstrated above, the Examiner has failed to fulfill this duty with respect to claims 3, 4, 6-8, 10-12, 14, 17, 18, 20-22, and 24-26. Therefore, the Final Office Action mailed on September 6, 2006 is improper and should be withdrawn.

REJECTION OF CLAIMS 1 AND 16 OVER THE SUBJECT MATTER OF THE GOSEWEHR
PROVISIONAL APPLICATION

Claims 1-4, 6-8, 10-12, 15-18, 20-22 and 24-26 have been rejected under 35 U.S.C. 102(e) as being anticipated by Gosewehr (2004/0249724).

Although the Examiner does not state proper reasons for rejecting claims 1 and 16 in the Claim Rejection section of the Office Action, she formulates these reasons in her Response to Arguments.

In particular, the Examiner asserts that the subject matter disclosed on pages 2 and 5 of the provisional application anticipates claims 1 and 16. This assertion is respectfully traversed for the following reasons.

Claim 1 recites a system for enabling a customer to order a required product, comprising:
a voice recognition mechanism for recognizing a voice input, and

a display mechanism responsive to the recognized voice input for displaying images assisting the customer in ordering the product during a product ordering session.

Claim 16 recites a method of ordering a product comprising the steps of:

recognizing a voice input from a customer, and

in response to the recognized voice input, displaying images assisting the customer in ordering the product during a product ordering session.

It is well settled that anticipation, under 35 U.S.C. § 102, requires that each element of a claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1920 (Fed. Cir. 1989) *cert. denied*, 110 S.Ct. 154 (1989).

As demonstrated below, the Gosewehr provisional application neither expressly nor inherently discloses the subject matter of claims 1 and 16.

As indicated by the Examiner, the provisional application discloses the animated guide that “will give audio and graphical assistance to customers in order to make the ordering process easy and efficient... The animated guide would be designed to communicate verbally and/or through gestures with what the customer is seeing on the order screen at that particular time, and will offer directions, tips, advice, or any other type of graphical or audio assistance that the customer might need.” (page 2).

Further, “[t]he animated guide could welcome the customer to the business and prompt them [sic] to make ordering decisions specific to each system by numerous methods including, but not limited to, touching parts of a touchscreen or voice recognition.” (page 5).

Accordingly, the provisional application **does not expressly disclose** that in response to the recognized voice input, the animated guide of Gosewehr displays images assisting the customer in ordering the product during a product ordering session, as claims 1 and 16 requires.

In the event the Examiner relied upon inherency without expressly indicating such reliance, the Examiner should be aware that inherency requires certainty, not speculation. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probability or possibilities. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner provided no factual basis upon which to conclude that in response to the recognized voice input, the animated guide of Gosewehr **necessarily** displays images assisting the customer in ordering the product during a product ordering session, as claims 1 and 16 requires.

However, one skilled in the art would understand that in response to the recognized voice input, the animated guide of Gosewehr may provide, for example, only a verbal response to the customer without displaying any image assisting the customer in ordering the product.

Therefore, one skilled in the art would recognize that the animated guide of Gosewehr does not **necessarily** respond to the recognized voice input by displaying images assisting the

customer in ordering the product during a product ordering session, as the claims 1 and 16 require.

Inasmuch as the Gosewehr provisional application neither expressly nor inherently discloses the above-discussed claimed feature, it cannot be said that the subject matter supported by this application describes the claimed invention within the meaning of 35 U.S.C. § 102. *Kalman v. Kimberly-Clark Corp., Richardson v. Suzuki Motor Co., supra.*

Accordingly, the Examiner's rejection of claims 1 and 16 under 35 U.S.C. 102 is improper and should be withdrawn.

EXAMINER'S POSITION THAT GOSEWEHR QUALIFIES AS PRIOR ART

In the Final Office Action (page 3), the Examiner asserts that the Gosewehr provisional application reasonably provides adequate 35 U.S.C. 112, first paragraph, support for the Gosewehr publication (and applicant's claimed invention), and the Gosewehr publication does qualify as prior art.

This assertion is respectfully traversed for the following reasons.

First, as discussed above, a reference, which claims priority to a prior US provisional application would be accorded the earlier filing data of the provisional application as its prior art date, assuming the earlier-filed application has proper support for the subject matter relied upon (MPEP 706.02(f)(1)).

However, the subject matter relied upon by the Examiner is absent in the Gosewehr provisional application. Therefore, the Gosewehr publication is not available as prior art in the Examiner's rejections of the claims.

Further, in accordance with 35 U.S.C. 112, first paragraph, the specification shall contain a written description of the invention to enable any person skilled in the art to make and use the invention.

However, as discussed above, the Gosewehr provisional application does not describe that in response to the recognized voice input, images are displayed assisting the customer in ordering the product during a product ordering session, as the claims 1 and 16 require. Therefore, the Gosewehr provisional application cannot support the subject matter corresponding to the claimed invention under 35 U.S.C. 112, first paragraph.

Moreover, it is respectfully submitted that the Gosewehr provisional application is not sufficient to provide support under 35 U.S.C. 112, first paragraph, even for the invention disclosed in the Gosewehr regular application.

For example, the ordering system described in the Gosewehr provisional application does not have a microphone or any other means for receiving a voice input from a customer. Therefore, it cannot support the respective features disclosed in the Gosewehr regular application.

It is noted that the inventor appears to realize that the disclosure in his provisional application is inadequate, because he mentions that a microphone may be added (see paragraph 40) in the regular application filed after the filing date of the present invention.

Accordingly, the Examiner's position with respect to support under 35 U.S.C. 112, first paragraph, is unwarranted.

REJECTION OF THE DEPENDENT CLAIMS

As discussed above, the Examiner has failed to state the reasons in support of her rejection of the dependent claims based on the subject matter supported by the Gosewehr provisional application.

It is respectfully submitted that the subject matter of the Gosewehr provisional application does not teach or suggest the inventions claimed in the dependent claims 2-15 and 17-28.

For example, the Gosewehr provisional application does not describe that:

- the voice recognition mechanism and the display mechanism are elements of a product ordering terminal in a retail facility, as claim 2 requires;

- the display mechanism is configured for displaying a control element for enabling the customer to modify a displayed image in a required manner when the customer selects the control element, and the voice recognition mechanism is configured to control the display mechanism so as to modify the displayed image in the required manner when a voice command corresponding to a function of the control element is recognized, as claims 3, 4, 17 and 18 recite;

- the voice input includes a voice command for requesting the display mechanism to switch to a desired screen which is not available by selecting the displayed control element, as claims 5 and 19 require;

- the voice input includes a voice command associated with an image displayed by the display mechanism to request the display mechanism to display a screen linked to the displayed image, as claims 6 and 20 require;

- the display mechanism is configured for displaying at least a first screen representing a first phase of the product ordering session and a second screen representing a second phase of the product ordering session, as claims 7 and 21 recite;

- the display mechanism is responsive to the recognized customer's voice input to replace the first screen with the second screen, as claims 8 and 22 require;

- where, the first screen and the second screen represent non-consecutive phases of the product ordering session, as claims 9 and 23 recite;

-the voice recognition mechanism is configured to recognize a first set of voice commands when the first screen is displayed, and a second set of voice commands when the second screen is displayed, as claims 10 and 24 require;

-where the first set of voice commands differs from the second set of voice commands, as claims 11 and 25 recite;

-the display mechanism is configured to display graphical elements indicating voice commands available in a particular phase of the product ordering session, as claims 12 and 26 require;

-voice commands recognizable by the voice recognition mechanism during the product ordering session include point-of-sale keywords for defining points of sales for delivery of an ordered product, as claims 13 and 27 recite;

-voice commands recognizable by the voice recognition mechanism during the product ordering session include product keywords for defining products available for ordering, as claims 14 and 28 require;

-a voice recording mechanism records the voice input to accumulate voice information for adjusting the voice recognition mechanism, as claim 15 recites.

Hence, the Examiner's rejections of these claims based on the Gosewehr publication are improper and should be withdrawn.

CONCLUSION

In view of the foregoing, and in summary, claims 1-28 are considered to be in condition for allowance. Favorable reconsideration of the application is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Alex Yampolsky', written over the firm name.

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